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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,139	03/06/2002	William D. Tandy	4333.1US (99-0257.1)	9714
24247	7590	11/21/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 11/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,139

Applicant(s)

TANDY ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8,9,11,12,14,16,17,19,20,22 and 24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,3,4,6,8,9,11,12,14,16,17,19,20,22 and 24 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 9/26/2005. Applicants' amendments to independent claims 1, 9 and 17 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. It should be noted that, upon reconsideration, the secondary reference of Robertson (US 5855969) is withdrawn from the grounds of rejection, because, in the absence of evidence to the contrary, it appears to be a routine experimentation to one skilled in the art of laser marking to select a markable material. Additionally, it is also noted that the chemistry or composition of the laser markable component is absent from the claims of instant invention. Finally, it should be noted that Applicants' arguments directed to Robertson reference are moot.

Rejections Based on Prior Art

4. Claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Weng et al. (US 5972234), generally as set forth in section 4 of Office action mailed 8/3/2005, together with the following response to argument.

First, for the purpose of clarity, the Examiner repeats the relied upon prior art as follows: Weng's invention is directed to a tape for marking a wafer (semiconductor

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device). The marking tape forms an identification mark by the use of a high-intensity energy beam (column 2, lines 20-21), such as a laser (column 1, line 32). Weng also teaches that any suitable tape of polymeric based material, which can be easily patterned by high-intensity energy beams such as ultraviolet light or laser, can be used (column 4, lines 27-33). The marking tape adheres to a substrate to be marked (column 2, line 64). A release layer (outer layer), such as a polypropylene or PET film, may be provided to cover the adhesive layer for protection during the laser marking process (column 4, line 64 to column 5, line 2). As to the two-layer adhesive structure, since both adhesive layers are merely recited as "a mixture of electromagnetic radiation-curable components", and the amended Fig. 5 (submitted 12/20/2004) also expressly shows that the two layers are of the same material 1B, the Examiner notes that Weng's adhesive single-layer structure reads on the two-layer adhesive structure of the instant invention as claimed, because the recited two-layer structure do not preclude the single layer structure of Weng. In particular, the Examiner notes that Weng's single layer of curable marking tape layer also inherently reads on the limitation "the second layer ... curing onto ... the first ... adhesive layer" as claimed.

Second, it is noted that independent claims 1, 9 and 17 have been amended to recite, *inter alia*, "flexible film material having a coefficient of thermal expansion substantially similar to the semiconductor device ... when laser marking a semiconductor". In response, the Examiner notes that while Weng is silent about the coefficient of thermal expansion of the release layer, Weng does expressly teach that the release layer may be formed of any suitable material (column 5, line 1). As such, in the absence of evidence to the contrary, since Weng expressly discloses the same

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subject matter and for the same application as the instant invention, it is the Examiner's position that a release layer having a suitable coefficient of thermal expansion is either anticipated by Weng, or obviously provided by practicing the invention of prior art. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01. As to the use process limitation "... when laser marking a semiconductor", the Examiner notes that since the use process limitation has not been shown on the record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious. Therefore, this limitation at the present time has not been given patentable weight.

With respect to Applicants' argument "Weng et al. reference, at best, teaches or suggests a tape having one single adhesive layer, not a tape having multilayer adhesive ... Weng et al. does not teach or suggest using a tape that has laser markable surface ... While ... Weng et al. ... teaching or suggesting a marking tape form making an identification mark by a high-intensity energy beam, no such invention is either enabled, or described ... any rejection based upon the Weng et al. reference is a hindsight reconstruction ... the claimed limitations ... having at least two layers of adhesive ... comprising a mixture of electromagnetic radiation-curable components ..." (Remarks, page 9), the Examiner notes that Weng *does disclose* an embodiment of the same subject matter as the instantly claimed invention, as set forth above. It is not seen why the rejection based upon the Weng et al. reference is a hindsight reconstruction. Specifically, while Weng is silent about the "multilayer adhesive", it has been shown that

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Weng's single layer reads on the two-layer structure of instant invention as claimed, as set forth above. As to the limitation of adhesive layer "comprising a mixture of electromagnetic radiation-curable components", the Examiner repeats that Weng does expressly teach that any suitable polymeric based material, which can be easily patterned by high-intensity energy beams such as ultraviolet light or laser, as set forth above. Further, such suitable material are known art, as evidenced by Applicants admission that "method used in the marking of a chip uses materials known in the art to be capable of changing color when contacted by a laser beam" (specification, paragraph 0008). In summary, while Weng teaches unrelated embodiments, Weng does disclose all the elements of the instant invention as claimed, Applicants' argument of "hindsight reconstruction" is not persuasive.

With respect to Applicants' repeated arguments "to include radiation-curable components into any adhesive layer formed in the tape disclosed by Weng et al. would render the invention inoperable. Specifically, applying radiation would *cure* the adhesive layer, which would prevent a pattern being formed through the tape. Therefore, no mark could be formed through the tape by an ablative photodecomposition process if the adhesive layer of the tape were to include radiation-curable components", etc. (Remarks, pages 10-11), the Examiner repeats that Applicants fail to provide any factual support for aforementioned arguments, and it is well settled that Attorney's arguments cannot take place of evidence. Further, Applicants' arguments appear to be directed to embodiments of Weng not relied upon, and as such appear to be misplaced.

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
Art Unit 1771

11/17/2005